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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/695,956	10/30/2003	Andreas Wachtler	MERCK-1497-D03	6268

23599 7590 05/03/2005

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EXAMINER

WU, SHEAN CHIU

ART UNIT	PAPER NUMBER
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1756

DATE MAILED: 05/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/695,956

Applicant(s)

WACHTLER ET AL.

Examiner

Shean C. Wu

Art Unit

1756

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 7-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 7-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 07/585,165.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities:

It is noted that the update priority data provided on 4/22/05 is incorrect. On page 1, 5th line below title "Phenylcyclohexanes" in continuation data, "August 13" should be changed to -- October 16 -- and after "1990" the data --, which is based on PCT/EP90/01330 filed on August 13, 1990 -- should be inserted.

Appropriate correction is required.

2. The indicated allowability of claims 1-5 and 7-14 are withdrawn in view of the newly discovered reference(s) to copending Application 09/964,650. Rejections based on the newly cited reference(s) follow.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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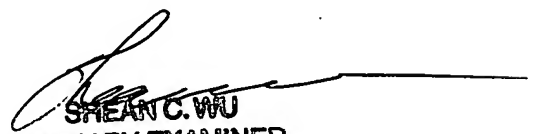
4. Claims 1-5 and 7-14 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 7-56 of copending Application No. 09/964,650. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claimed subject matters overlap each other.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shean C. Wu whose telephone number is 571-272-1393. The examiner can normally be reached on 9:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Huff can be reached on 571-272-1385. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

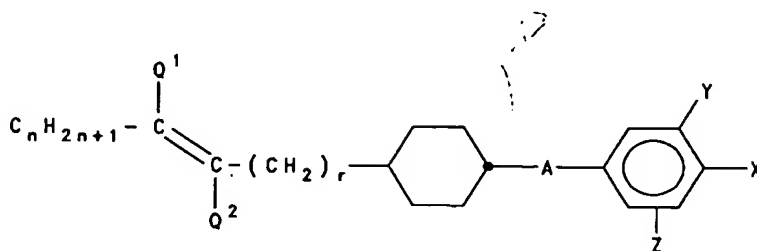
Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


SHEAN C. WU
PRIMARY EXAMINER

This listing of claims will replace all prior versions, and listings, of claims in the application:

Listing of Claims:

1. (Previously Presented) A phenylcyclohexane of formula I



in which n is 0 to 7, Q¹ and Q² are H, or one of these radicals is alternatively CH₃, r is 0 or 2, A is trans-1,4-cyclohexylene, 1,4-phenylene, 3-fluoro-1,4-phenylene or a single bond, X is F, Cl, CF₃, -CN, OCF₃, or -OCHF₂, and Y and Z are each, independently of one another, H or F, with the proviso that, in the case where A is a single bond, Q¹ = Q² = H and simultaneously X = CN, Y and/or Z are F.

2. (Previously Presented) A phenylcyclohexane according to claim 1, wherein X is F, Cl, -CF₃ or -OCF₃.

3. (Previously Presented) A phenylcyclohexane according to claim 1, wherein Y = Z = H.

4. (Previously Presented) Phenylcyclohexanes according to claim 1, wherein, Y = F and Z = H or F.

5. (Previously Presented) A phenylcyclohexane according to claim 1, wherein X = CN, Y = F and Z = H or F.

6. (Canceled)

7. (Previously Presented) A liquid-crystalline medium having at least two liquid-crystalline components, wherein at least one component is a phenylcyclohexane of the formula I according to claim 1.

8. (Previously Presented) An electrooptical display based on a liquid-crystal cell, wherein the liquid-crystal cell contains a medium according to claim 7.

9. (Currently Amended) A phenylcyclohexane according to claim 1, wherein r is 0.

10. (Currently Amended) A phenylcyclohexane according to claim 1, wherein r is 2.

11. (Previously Presented) A liquid crystalline medium having at least two liquid crystalline components, wherein at least one component is a phenylcyclohexane of the formula I according to claim 9.

12. (Previously Presented) An electrooptical display based on a liquid-crystal cell, wherein the liquid-crystal cell contains a medium according to claim 11.

13. (Previously Presented) A liquid crystalline medium having at least two liquid crystalline components, wherein at least one component is a phenylcyclohexane of the formula I according to claim 10.

14. (Previously Presented) An electrooptical display based on a liquid-crystal cell, wherein the liquid-crystal cell contains a medium according to claim 13.